

PATENT
Atty. Dkt. No. 054707-0185

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Joseph P. STEINER et al.

Title: NOVEL PYRROLIDINE
CARBOXYLATE HAIR
REVITALIZING AGENTS

Appl. No.: 09/825,896

Filing Date: 4/5/2001

Examiner: Rebecca COOK

Art Unit: 1614

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Your Petitioner, GPI NIL Holdings Inc., having its principal place of business at 222 Delaware Avenue, Wilmington, Delaware 19899, represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application No. 09/825,896, filed April 5, 2001, which is a divisional application of U.S. Patent Application No. 09/369,860, filed August 9, 1999, and now U.S. Patent No. 6,239,164, which is a divisional application of U.S. Patent Application No. 08/869,426, filed June 4, 1997, and now U.S. Patent No. 5,945,441. Your Petitioner represents that it is the owner of U.S. Patent Nos. 5,945,441 and 6,239,164 by virtue of an Assignment filed and recorded on April 21, 1999, on Reel/Frame 9903/0481, in the United States Patent and Trademark Office, a copy of which is attached hereto as **APPENDIX A**.

Further, your petitioner represents that its Assignor, Guilford Pharmaceuticals Inc., was the owner of the entire right, title, and interest by virtue of an

Assignment filed and recorded on January, 26, 1998, on Reel/Frame 8894/0426, in the United States Patent and Trademark Office.

Your Petitioner, GPI NIL Holdings Inc., hereby disclaims the terminal part of the term of any patent granted on the above identified patent application which would extend beyond the full statutory term, as presently shortened by any terminal disclaimer, of U.S. Patent 6,239,164, and hereby agrees that any patent so granted on the above identified patent application shall be enforceable only for and during such period that the legal title to U.S. Patent 6,239,164 shall be the same as the legal title to any patent granted on the above identified patent application, this agreement to run with any patent granted on the above identified patent application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on the above identified patent application, prior to the full statutory term of U.S. Patent 6,239,164 as defined in 35 U.S.C. §§ 154-156, in the event that U.S. Patent 6,239,164 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC § 154, prior to the full statutory term of U.S. Patent 6,239,164 as defined in 35 USC §§ 154-156, except for the separation of legal title stated above. Further, Petitioner does not disclaim any terminal part of a patent granted on the above identified patent application that would extend beyond the present termination of U.S. Patent 6,239,164, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on the above identified patent application to the extent provided by law.

The undersigned, being the Attorney of Record for the above identified patent application, and duly authorized to act on behalf of Petitioner, certifies that she has reviewed the Assignments attached as **APPENDIX A**, and to the best of her knowledge and belief, legal title to the above identified patent application and U.S. Patent 6,239,164 rests with Petitioner, GPI NIL Holdings Inc. The undersigned declares that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date

14 March 2005

By

Stephen A. Bent

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

Stephen A. Bent
Attorney for Applicant
Registration No. 29,768



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Assignments on the Web > Patent Query

Patent Assignment Abstract of Title

**NOTE: Results display only for issued patents and published applications.
For pending or abandoned applications please consult USPTO staff.**

Total Assignments: 2**Patent #:** [5945441](#) **Issue Dt:** 08/31/1999 **Application #:** 08869426 **Filing Dt:** 06/04/1997**Inventors:** JOSEPH P. STEINER, GREGORY S. HAMILTON**Title:** NOVEL PYRROLIDINE CARBOXYLATE HAIR REVITALIZING AGENTS**Assignment: 1****Reel/Frame:** [008894/0426](#)**Recorded:** 01/07/1998**Pages:** 3**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignors:** [STEINER, JOSEPH P.](#)**Exec Dt:** 09/18/1997[HAMILTON, GREGORY S.](#)**Exec Dt:** 09/19/1997**Assignee:** [GUILFORD PHARMACEUTICALS INC.](#)6611 TRIBUTARY STREET
BALTIMORE, MARYLAND 21224**Correspondent:** NATH & ASSOCIATESGARY M. NATH
1835 K STREET, N.W., SUITE 750
WASHINGTON, D.C. 20006-1203**Assignment: 2****Reel/Frame:** [009903/0481](#)**Recorded:** 04/21/1999**Pages:** 4**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignor:** [GUILFORD PHARMACEUTICALS INC.](#)**Exec Dt:** 04/05/1999**Assignee:** [GPI NIL HOLDINGS, INC.](#)222 DELAWARE AVENUE
WILMINGTON, DELAWARE 19899**Correspondent:** NATH & ASSOCIATESGARY M. NATH
1030 15TH STREET, N.W. - 6TH FLOOR
WASHINGTON, D.C. 20005

Search Results as of: 03/09/2005 11:33 AM

If you have any comments or questions concerning the data displayed, contact OPR / Assignments at 703-308-9723

[| .HOME](#) | [| INDEX](#) | [| SEARCH](#) | [| eBUSINESS](#) | [| CONTACT US](#) | [| PRIVACY STATEMENT](#)



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JUNE 29, 1999

PTAS

NATH & ASSOCIATES
GARY M. NATH
1030 15TH STREET, N.W. - 6TH FLOOR
WASHINGTON, D.C. 20005



101021257A

**UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT**

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 04/21/1999

REEL/FRAME: 9903/0481
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
GUILFORD PHARMACEUTICALS INC.

DOC DATE: 04/05/1999

ASSIGNEE:
GPI NIL HOLDINGS, INC.
222 DELAWARE AVENUE
WILMINGTON, DELAWARE 19899

SERIAL NUMBER: 08869426
PATENT NUMBER:

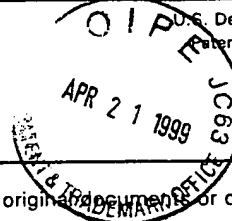
FILING DATE: 06/04/1997
ISSUE DATE:

DOROTHY RILEY, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

04-27-1999



101021257

U.S. Department of Commerce
Patent and Trademark Office

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original document or copy thereof.

1. Name of Conveying Party:

GUILFORD PHARMACEUTICALS INC.

☐ Additional names of conveying parties attached.

3. Nature of Conveyance

☒ Assignment☐ Security Agreement☐ Other:☐ Merger☐ Change of Name

Execution Date: April 5, 1999

2. Name and Address of Receiving Party(ies):

Name: GPI NIL HOLDINGS, INC.

Street Address: 222 Delaware Avenue

City, State, Zip: Wilmington, DE 19899

☐ Additional name(s) and address(es) attached.

4. (A) Patent Application Number(s):

08/869,426

If this document is being filed together with a new application, the execution date of the application is:

☐ Additional Numbers Attached.

4. (B) Patent Number(s):

5. Name and Address of Party to whom Correspondence Concerning this Document Should be Mailed:

Name: Gary M. Nath
Address: NATH & ASSOCIATES
1030 15th Street, N.W. - 6th Floor
Washington, D.C. 20005

6. Total Number of Applications and Patents Involved:

1

7. Total Fee:

(37 CFR 3.41)

\$ 40.00

☒ Enclosed.☐ Authorized to be charged to deposit account.

8. Deposit Account Number:

14-0112

ATTACH DUPLICATE COPY OF THIS PAGE IF PAYING BY DEPOSIT ACCOUNT

DO NOT USE THIS SPACE

9. Statement and Signature:

To the best of my knowledge and belief, the foregoing is true and correct and any attached copy is a true copy of the original document.

Name of Person Signing

Gary M. Nath, Reg. No. 26,965

April 21, 1999
Date

Attorney Docket No.: 23105

Total number of pages comprising cover sheet: 1

04/26/1999 DNGUYEN 00000185 08869426

01 FC:581

40.00

4-21-99

ASSIGNMENT

FOR GOOD AND VALUABLE CONSIDERATION given to **GUILFORD PHARMACEUTICALS INC.**, hereinafter referred to as the ASSIGNOR(S), who has/have invented certain new and useful **NOVEL PYRROLIDINE CARBOXYLATE HAIR REVITALIZING AGENTS**, hereinafter referred to as the invention, for which I/we has/have executed an application for Letters Patent to be filed in the United States Patent and Trademark Office.

WHEREAS, **GPI NIL HOLDINGS, INC.**, a corporation organized and existing under the laws of the country/state of Delaware, whose post office address/business address is 222 Delaware Avenue, Wilmington, DE 19899, hereinafter referred to as the ASSIGNEE, desires to acquire the entire right, title and interest for the United States and elsewhere throughout the world in and to said invention and application, including any and all divisions and continuations thereof, all rights of priority under the terms of the International Convention for the Protection of Industrial Property, and any and all Letters Patent which may be granted thereon, including any and all renewals, reissues and prolongations thereof.

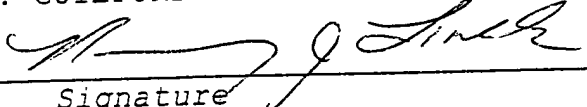
NOW, WITNESSETH THIS that for and in consideration of the sum of one dollar (\$1.00) and other good and valuable consideration, the receipt, adequacy and sufficiency of which are hereby acknowledged, said ASSIGNOR(S) hereby assign(s), sell(s) and transfer(s) to said ASSIGNEE, its assigns and legal representatives, the entire right, title and interest for the United States and elsewhere throughout the world, in and to said invention and application, including any and all divisions and continuations thereof, all rights of priority under the terms of the International Convention for the Protection of Industrial Property, and any and all Letters Patent which may be granted thereon, including any and all renewals, reissues and prolongations thereof, with all the rights, powers, privileges, and advantages in any way arising from or pertaining thereto, for and during the term or terms of any and all such Letters Patent when granted, including any and all renewals, reissues and prolongations thereof, for the use and benefit of said ASSIGNEE and its assigns and legal representatives, in as ample and as beneficial a manner for all intents and purposes as said ASSIGNOR(S) might or could have held and enjoyed the same had this assignment not been made.

ASSIGNMENT

ALSO, said ASSIGNOR(S) hereby agree(s) to execute all papers necessary to file said applications in the United States and elsewhere throughout the world, and to assign the same to said ASSIGNEE, or any assignee acquiring title to said invention, and to execute any other papers that may be needed in connection with filing said application and securing any and all Letters Patent thereon.

AND said ASSIGNOR(S) authorize(s) and request(s) the Commissioner of Patents to issue a Letters Patent on said application, and on any and all divisions and continuations thereof, to said ASSIGNEE, its assigns and legal representatives, in accordance herewith.

By: GUILFORD PHARMACEUTICALS INC.



Signature

4/5/99

Date

Nancy J. Linck

Name

VP, Intellectual Property

Title